

Serial No. 10/809,158

PD-203061

REMARKS

Claims 1, 3-8, 10-13 and 36-37 are pending in the present application. No claims have been amended.

On August 8, 2007, Examiner John Sipos and attorney Eric Gifford for Applicant conducted a telephone interview to discuss the final office action and previously submitted affidavit more particularly resubmission of a corrected Affidavit under 1.32. Examiner stated that the affidavit should be tied to the subject matter being claimed and if no amendments to the claims or new issues in the affidavit are submitted the affidavit may be considered.

The current response resubmits the previously presented claims, remarks and affidavit with the only change being to provide reference in the Affidavit to the specific claims and features of those claims addressed in the Affidavit to provide the requisite objective evidence of nonobviousness commensurate in scope with the claims. No new substantive issues are raised for consideration. Entry and reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103

Claims 1,3-9, 11-13 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art (APA) of pages 1-3 of the instant specification in view of Limelett (6,899,276). Claim 10 was rejected as being unpatentable of APA in view of Limelette and in view of APA2. Claims 1, 2-9, 11-13 and 36 were rejected as being unpatentable over APA in view of Roshkoff (6,042,149) or alternatively Roshkoff in view of APA. These rejections are respectively traversed.

In rejecting the claims, the Examiner states that APA comprises the placing of a Smart Card having a bar code in an envelope that is preprinted with a license agreement and then sealing the envelope. The envelope has a window that makes the bar code visible without opening the envelope. The opening of the preprinted envelop indicates acceptance of the agreement by the customer. This APA lacks the use of a film for packaging and lacks the use of a licensing agreement that is larger than the footprint of the package. Limelette shows the wrapping of a data-encoded card in a polypropylene film that comprises a window portion to provide visibility of the card. Roshkoff shows the wrapping of Smart Card 18 in transparent plastic film 10 that provides visibility of bar code printed on the Smart Card and with the exterior surface of the film 14 carrying printed matter. In both cases, the Examiner states that it would

Serial No. 10/809,158

PD-203061

have been obvious to one skilled in the art to use a film (as taught by Limelette or Roshkoff) to package the Smart Card of the APA instead of paper envelope.

Claims 1 and 36 claim an anti-static treated polypropylene/polyethylene film 0.50 to 1.75 mil thick preprinted with a licensing agreement, pulling the next card from a card feeder 'without touching the electronic module', and passing the film over an anti-static bar prior to wrapping to form the package. See p. 6, l. 25-29; p. 9, l. 11-16; p. 10, l. 4-6. Claim 13 as dependent from claim 1 and claim 36 further recite that the embedded module is encoded with certain identification, service and security information for use with an integrated receiver decoder (IRD) set-top boxes and a digital video recorder (DVR) to provide secure satellite television services. See p. 2, l. 28-32. Claims 4 and 37 specify that the license agreement wraps around the smart card (access card). Roshkoff affixes the label to the container, clearly any printing particularly a legally binding license would not be wrapped around to the back of the label.

Applicant reaffirms its position that the combination as claimed in claims 1 and 36 and dependent claims 3-9 and 11-13 are nonobvious over the prior art of record. Applicant specifically notes that the cited art does not teach using both an anti-static treated film and an anti-static bar to protect the module, the claimed thickness range of the film, or pulling the smart card from the feeder without touching the module. Conventional kitting machines use a roller that contacts the entire surface of the card as it pulls it from the feeder. This combination of features is not common knowledge in the packaging art and not merely a matter of experimentation.

To support Applicant's position of nonobviousness we are submitting the declaration of the inventor Pelegrin Torres Jr. under 37 CFR 1.132. As presented in Mr. Torres' declaration there is a close nexus between the merits of the claimed invention and the evidence of the criticality of the results and commercial success commensurate in scope with the claims. The claimed method was critical to protect the Smart Card, provide an enforceable license and to provide the high throughput required by DIRECTV and has achieved considerable commercial success for DIRECTV because the invention achieved all three requirements. The commercial success is commensurate with the scope of the claims and is derived from the claimed invention.

Applicant respectfully submits that the objective evidence of nonobvious overcomes the Examiner's grounds for rejection. Applicant asks that the rejection be withdrawn and a notice of allowance issued.

Serial No. 10/809,158

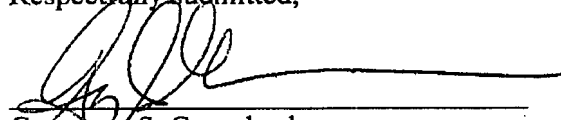
PD-203061

II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below listed telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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